

## **REMARKS**

Reconsideration of the above-identified application in view of the amendments above and the following remarks is respectfully requested. No new material has been entered.

### **Claims**

Claims 1 – 9 and 11 – 33 are in this case.

- The Examiner has rejected claims 1 – 9, 11 – 23, and 31 – 33 under 35 USC §101, as being directed to non-statutory subject matter.
- The Examiner has further rejected claims 1 – 5, 11, 17, 23, and 31 – 33 under 35 USC §102 as being anticipated by Yahoo Games (“Yahoo”).
- The Examiner has moreover rejected claims 6 – 9, 12, 13 – 16, 18 – 22, and 24 – 30 under 35 USC §103(a) as being unpatentable over Yahoo in view of various other prior art as cited in the Office Action.

### **Examiner’s Arguments and Rejections**

The Examiner’s points and rejections have all been given full and careful consideration, and in each case, the respective claims have been amended (as presented above) to be responsive to those points and rejections. The Applicant therefore respectfully puts forth that the amended claims, as presented above, overcome the Examiner’s rejections. It is noted that certain claims have been consolidated, and in keeping with this consolidation, claims 12, 25, and 27 have been canceled.

For the convenience of the Examiner, the nature of the amendments and how they overcome the rejections is discussed below.

### **§101 Rejections**

As noted above, the Examiner has rejected claims 1 – 9, 11 – 23, and 31 – 33 under 35 USC §101, as being directed to non-statutory subject matter. In accordance with the Examiner's analysis, the independent claims of the present application have been amended to include limitations which clearly and explicitly relate to computers, data processing systems, and their input/output, in a manner consistent with the intent of the invention and the description/disclosure thereof in the specification of the present application. The claims therefore relate to subject matter which is tied to technical arts, environments, and machines, and which result in practical applications producing concrete, useful, and tangible results in statutory classes recognized by the United States Patent and Trademark Office. The Applicant therefore respectfully puts forth that all the claims, as presently amended above, are now directed to statutory subject matter in full compliance with 35 USC §101.

### **§102 Rejections**

As noted above, the Examiner has rejected claims 1 – 5, 11, 17, 23, and 31 – 33 under 35 USC §102 as being anticipated by Yahoo Games ("Yahoo"). This rejection is respectfully traversed, with reference to a similar traverse in the Applicant's previous response to the Office Action mailed March 7, 2005. In summary, the Applicant respectfully puts forth that:

- Yahoo fails to anticipate any claims of the present application, both as a disclosure and as evidence of actual use. In a rebuttal of this position, the present Office Action states that "... the Java Applet of Yahoo Games is the deliverable published software, which contains the personalization." [Office Action mailed May 25, 2005, page 14] The Applicant, however, respectfully maintains that this representation of the structure of Yahoo Games is a

supposition which is not supported by any of the documents submitted as prior art. In particular, the prior art Yahoo documents make no disclosure whatsoever of the inclusion of personal information in any applets, Java code, or other software. The Yahoo documents furthermore do not even reasonably suggest the inclusion of personal information in software. To the contrary, the Yahoo documents (as is discussed in detail, with citations, in the Applicant's response to the Office Action mailed March 7, 2005) explicitly state that personal information utilized by Yahoo is contained in "Yahoo Profiles" which are collected by Yahoo for use in a searchable on-line database, and it is from this database that all personal information is taken and delivered to game-playing users as data, not within software, for display purposes.

- To whatever extent Yahoo may display personal information, Yahoo's purpose is to support game-playing (by displaying player names and ratings), rather than for protection of software against unauthorized copying and distribution (by displaying the name of the authorized user of the software), which is the objective of the present invention. The Examiner, however, has argued that this objective of software protection does not carry patentable weight in the claim preamble recitations. The Examiner also noted that there were no specific references to case law in the response to the Office Action mailed March 7, 2005 regarding the giving of patentable weight to preamble recitations. [Office Action mailed May 25, 2005, page 14]

Court decisions relevant to this issue include:

- *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995),

where the court held that a “claim preamble has the import that the claim as a whole suggests for it”;

- *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999), where the court held that “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim”;
- *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), where the court held that the claim recitation “gave life and meaning to the preamble’s statement of purpose”;
- *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), where the court held that the preamble served to further define the structure of the claim; and
- *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966, where the court held that the status of limitations in the preamble must be resolved by review of the entire case, “to gain an understanding of what the inventors actually invented and intended to encompass by the claim”.

While continuing to respectfully traverse the above-referenced 35 USC §102 rejections, the Applicant has elected to amend the claims to take into account the points raised by the Examiner, and thereby to overcome the rejections by amendments which comply with the Examiner’s arguments. Specifically, each independent claim of the present application has been amended in the following manner:

- The limitation of protecting software against unauthorized copying and distribution has been presented in more detail, both in the preamble and in the body of the claim, in a manner consistent with the intent of the invention and the description/disclosure thereof in the specification of the present application. It is the Applicant's intention to distinguish the present invention in the claims from any possible confusion with the prior art (such as Yahoo Games), including the intended goal of software protection and the limitations necessitated thereby; and in a manner such that the limitations appear in the body of the claim and thereby carry patentable weight.
- Additional structural limitations have been recited in the claims, for features which are intended to protect the software from unauthorized copying and distribution by associating the software with the authorized user (the "customer") via a personalization, and providing for the display of this information to users as, and by means of, a notification that the identified customer is the authorized user of the software.

The Applicant respectfully maintains that these structural limitations recited in the claims are wholly absent from the cited prior art, thereby establishing the novelty of the present invention. For example, Yahoo Games software does not display a notification that the named user is an authorized user of the software, nor does Yahoo Games provide an authentication or validation of personal information as having come from Yahoo Games and being unaltered.

The Applicant further respectfully maintains that because of the material differences in purpose (software protection in the case of the present invention, versus support for game-playing in the case of the prior art), these specific structural limitations intended for software protection are neither

reasonably suggested by the prior art nor can be reasonably inferred therefrom, thereby establishing the non-obviousness of the present invention as presented in the claims.

### **§103 Rejections**

As noted above, the Examiner has rejected claims 6 – 9, 12, 13 – 16, 18 – 22, and 24 – 30 under 35 USC §103(a) as being unpatentable over Yahoo in view of various other prior art as cited in the Office Action.

The Applicant has elected to amend the independent claims with limitations that overcome the §103 rejections, as explained below.

Regarding the issue of authentication and validation of the personal information, the Office Action contends that applying prior art authentication and validation would be obvious, and suggests that “Motivation to do so would have been to verify that the information that was created by a user is actually from the user and that it hasn’t changed (see Menezes et al page 25)” [Office Action mailed May 25, 2005, pages 7, 11]. The amended claims of the present application, however, recite the limitation that the authentication be done by the software publisher (not the user) and that the validation determine that the authenticated personalization originated specifically from the software publisher (not the user) and that it has not been altered.

The Applicant respectfully maintains that the prior art regarding authentication and validation which was cited in the Office Action (Menezes, Pratt, etc.) addresses authentication and validation only as a data checking tool in general, rather than in the specifically-limiting case of authentication by the software publisher and validation thereof. This specific limitation in the amended claims describes a non-obvious use of authentication and validation which is not suggested by the cited prior art. In particular, there is no incentive for anyone to engage in unauthorized copying and distribution of

Yahoo Games software, because the software is available to the public and distributed free of charge to whoever wants it. Whatever need Yahoo Games might have to verify that the software has not been altered on its way to the user (such as alterations caused by transmission errors) is easily satisfied by normal network source-to-destination data integrity-checking, such as that provided by the Internet. Thus, there is no reasonable motivation for authentication or validation (in the manner of Menezes, Pratt, etc.) of the contents of the Yahoo Games software as having originated from Yahoo Games. Moreover, 35 U.S.C. 103(a) stipulates that “the subject matter as a whole” is to be considered when determining whether the invention would have been obvious. The subject matter of the present invention as a whole is such that having the software publisher authenticate the customer’s (the authorized user’s) personal information — and later having the executed software validate the authentication as having come from the software publisher without alteration — makes sense in the context of the present invention (protecting the software against unauthorized copying and duplication, by displaying the authorized user’s name with the software in a tamper-resistant manner), but serves no purpose in the prior art contexts, such as game-playing (where the issue of who is an authorized user of the software is completely irrelevant to the playing of the game). Therefore, it would not be obvious in the context of Yahoo Games software to apply authentication and validation to that software in the same manner provided by the amended claims of the present invention.

Accordingly, the Applicant respectfully puts forth that the new limitations in the amended claims herewith serve to overcome the §103 rejections.

#### **Support in the Specification for the Amended Claims**

The amended claims conform to the general nature of the present invention as disclosed throughout the application, such that all the features corresponding to the included limitations appear in the specification.

Specifically: the identification of the “customer” as the “authorized user” is disclosed on page 31, lines 8 - 9; the inclusion of the customer name in the personalization is disclosed on page 41, lines 7-8, and the receiving of this information by the software publisher from the customer is disclosed in Figure 3; the authentication of the customer personalization by the software publisher and the subsequent validation thereof to determine that it was originated by the software publisher and not altered is disclosed on page 63, lines 10-20; the display of a notification containing the authorized user’s personal information (including the authorized user’s name) is disclosed on page 68 line 13 - page 69 line 2.

### Summary

The Examiner’s comments, analysis, and observations have been given careful and thorough consideration in the above amendments and remarks.

The Applicant believes that the claims are now in conformance with 35 USC §101; that structural limitations in the body of the claims now clearly distinguish the claims as novel over the prior art; and that additional structural limitations in the body of the claims now render the claims as non-obvious in view of the prior art.

It is therefore respectfully submitted that claims 1 - 9, 11, 13 - 24, 26, and 28 - 33 are in condition for allowance. Notice of allowance is therefore respectfully and earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Moshe Brody', is written over a horizontal line.

Moshe Brody, Applicant

Date: August 15, 2005